UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Ex parte C. ALEXANDER TURNER JR., ERIN HILBUN, GREGORY DONOHO, GLENN FRIEDRICH, ALEJANDRO ABUIN, BRIAN ZAMBROWICZ and ARTHUR T. SANDS

Appeal No. 2004-1536
Application No. 09/863,824

ORDER UNDER 37 CFR § 1.196(d)

Before WILLIAM F. SMITH, MILLS and GRIMES, Administrative Patent Judges.

GRIMES, Administrative Patent Judge.

ORDER UNDER 37 CFR § 1.196(d)

Under the provisions of 37 CFR § 1.196(d),[1] we require Appellants to address the following matters:

We invite attention to commonly assigned Application No. 09/804,969.[2] That application was the subject of an appeal to this board (Appeal No. 2003-1794), which was decided on April 14, 2004.

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[1] "The Board of Patent Appeals and Interferences may require appellant to address any matter that is deemed appropriate for a reasoned decision on the pending appeal. Appellant will be given a non-extendable time period within which to respond to such a requirement." 37 CFR § 1.196(d).

The issues and arguments in Appeal No. 2003-1794 bear close resemblance to those in this appeal. In Appeal No. 2003-1794, the broadest independent claim (claim 10) was directed to "[a]n isolated nucleic acid molecule encoding the amino acid sequence described in SEQ ID NO:15." The polypeptide of SEQ ID NO:15 was disclosed to have sequence similarity to animal phospholipases, but the specification did not disclose the biological function of the putative phospholipase of SEQ ID NO:15. The only issue in Appeal No. 2003-1794 was whether the specification disclosed a patentable utility for the claimed invention.

In Appeal No. 2003-1794, the appellants argued, among other things, that the claimed nucleic acids had utility because they could be used in methods that do not depend on the biological activity of the encoded protein. The appellants argued that "the presently claimed polynucleotide sequence provides biologically validated empirical data . . . that specifically define that portion of the corresponding genomic locus," that "the described sequences are useful for functionally defining exon splice-junctions," and that "the practical scientific value of expressed, spliced, and polyadenylated mRNA sequences is readily apparent to those skilled in the relevant biological and biochemical arts." Application No. 09/804,969, Paper No. 21, page 16.

The appellants in Appeal No. 2003-1794 also argued that the claimed nucleic acid "would be an ideal, novel candidate for assessing gene expression using, for example, DNA chips." Id., page 15. The appellants argued that "[s]uch 'DNA chips'

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[2] The named inventors in the instant application are C. Alexander Turner, Jr., Erin Hilbun, Gregory Donoho, Glenn Friedrich, Alejandro Abuin, Brian Zambrowicz, and Arthur T. Sands. In Application No. 09/804,969, the inventors are Yu Hi, Gregory Donoho, Erin Hilbun, C. Alexander Turner, Jr., Alejandro Abuin, Glenn Friedrich, Brian Zambrowicz, and Arthur T. Sands.

clearly have utility, as evidenced by hundreds of issued U.S. Patents. . . . Clearly, compositions that enhance the utility of DNA chips, such as the presently claimed nucleotide sequence, must also be useful." Id.

The panel that decided Appeal No. 2003-1794 reviewed governing principles of law; addressed and rejected the appellants' arguments premised on DNA chips, gene mapping, and exon splice junctions; and concluded that "Appellants' disclosure in th[at] case does not provide a specific benefit in currently available form, and therefore lacks the substantial utility required by 35 U.S.C. § 101." Id., page 27. Accordingly, the examiner's decision, rejecting all of the pending claims in Application No. 09/804,969, was affirmed.

As in Application No. 09/804,969, the broadest independent claim (claim 1) in this appeal is directed to "[a]n isolated nucleic acid comprising a nucleotide sequence that encodes an amino acid sequence drawn from the group consisting of SEQ ID NOS:2, 4 and 6." In this case, the polypeptides of SEQ ID NOS:2, 4, and 6 are disclosed to "share sequence similarity with mammalian thrombospondin proteins." Specification, page 1. The specification, however, does not disclose the biological activity or function of any of the polypeptides of SEQ ID NOS:2, 4, or 6. The only issue in this appeal is whether the specification discloses a patentable utility for the claimed invention. Examiner's Answer, page 4.

The Appeal Brief in this appeal includes essentially the same arguments that were made and rejected by the previous merits panel in Appeal No. 2003-1794. For example, Appellants argue that:

- "[K]nowledge of the exact function or role of the presently claimed sequence[s]

is not required to track expression patterns using a DNA chip" (Appeal Brief, page 10; emphasis in original);

• "Further evidence of utility . . . is the specific utility the present nucleotide sequence has [sic, sequences have] in determining the genomic structure of the corresponding human chromosome . . ., for example mapping the protein encoding regions." (id., page 12; emphasis in original);

• "[T]he described sequences are useful for functionally defining exon splice-junctions" (id.);

• "[T]he practical scientific value of expressed, spliced, and polyadenylated mRNA sequences is readily apparent to those skilled in the relevant biological and biochemical arts." (id.); and

• "[The present nucleotide sequence [sic, sequences] would be an ideal, novel candidate for assessing gene expression using, for example, DNA chips. . . . Such 'DNA chips' clearly have utility, as evidenced by hundreds of issued U.S. Patents. . . . Clearly, compositions that enhance the utility of DNA chips, such as the presently claimed nucleotide sequence, must in themselves be useful" (id., pages 10-11; emphasis in original).

On these facts, we require Appellants to explain why we should again address the same line of argument in this case: since the same arguments were considered and thoroughly addressed in Appeal No. 2003-1794, why would the previous panel's treatment of those arguments not be dispositive here? In particular, why should the facts and arguments set forth in the briefing of this appeal lead to a different conclusion than that reached by the panel in Appeal No. 2003-1794, which rejected the same arguments? We note that, according to PTO records, the appellants in Appeal No. 2003-1794 (Application No. 09/804,969) did not request rehearing under 37 CFR § 1.197(b), nor did they appeal the Board's decision.

Conclusion

In conclusion, we require Appellants to address the foregoing matters "deemed appropriate for a reasoned decision on the pending appeal." 37 CFR § 1.196(d)(2003).

We caution, however, that this is not an invitation to expand on points raised in the Appellants' brief or to rehash arguments already set forth in the brief. This is not an invitation to raise arguments or issues on appeal, or to collaterally attack the decision in Appeal No. 2003-1794. See 37 CFR § 1.192(a) (Brief must "set forth the authorities and arguments on which appellant will rely to maintain the appeal. Any arguments or authorities not included in the brief will be refused consideration by the Board of Patent Appeals and Interferences, unless good cause is shown"). Appellants' response should be confined to the matters outlined above.

Time Period For Response

A period of one month from the date of this order is set for Appellants' response. This time is non-extendable.

Failure to respond in a timely manner will result in dismissal of the appeal.

37 CFR § 1.196(d)

William F. Smith
Administrative Patent Judge

Demetra J. Mills
Administrative Patent Judge

Eric Grimes
Administrative Patent Judge

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